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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,274	10/13/2006	Yuichi Tsuji	71,051-022	6627
27305 7590 10/08/2009 HOWARD & HOWARD ATTORNEYS PLLC 450 West Fourth Street Royal Oak, MI 48067				
EXAMINER				
ZIMMER, MARC S				
ART UNIT		PAPER NUMBER		
1796				
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10/08/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/553,274

**Applicant(s)**

TSUJI ET AL.

**Examiner**

MARC S. ZIMMER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field et al., U.S. Patent # 4,515,884 in view of Badesha et al., U.S. Patent # 5,846,643 and/or Schlueter, U.S. Patent # 4,763,158 and also, Shudo et al., U.S. Patent Application Publication No. 2002/0146575 for the reasons outlined in the April 15, 2009 correspondence.

Applicant contends that Schlueter not only fails to establish that a hydrosilylation-curable composition would be regarded by the skilled artisan as an equivalent host matrix to a condensation-curable silicone for the purpose of manufacturing fuser rolls but, further, actually teaches away from the insertion of materials required by the claims into a hydrosilylation-curable silicone. The Examiner respectfully disagrees with both points.

First of all, Schlueter does not discourage the incorporation of any conductive materials but, rather, those that have high surface energies. Also, it is inarguable that, like Field et al., Schlueter teaches a silicone-based composition for manufacturing fuser rolls and, further, that both condensation-curable compositions and addition-curable siloxane hosts are contemplated in column 5, line 67 through column 7, line 21 without a stated preference of one

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over the other. Hence, they are regarded as equally capable of fulfilling the role of polymer host. As to the notion that *Schlueter* teaches away from the addition of iron oxide and alumina, the Examiner acknowledges this fact but disagrees with any assertion that they are to be avoided only in hydrosilylation-cured systems. One of ordinary skill in the art having read all of these teachings in their proper context would appreciate that the same deleterious effect associated with these fillers would be observed in any of the silicone hosts disclosed thereafter regardless of the mechanism by which they cure.

Of course, *Field* is clearly unconcerned about their effects given that he expressly advocates the incorporation of alumina and iron oxide and, anyway, *Schlueter* was relied upon merely to illustrate that the skilled artisan recognizes that condensation-curable silicones and addition-curable silicones may be used in the same capacity and that one is not regarded as superior to the other.

As for the cerium oxide component, Applicant remarks that *Shudo* gives no direction as to how much cerium oxide would be incorporated into the composition of *Field*. While the Examiner believes that the skilled artisan would clearly be motivated by *Shudo* to incorporate cerium oxide given the role of the composition described by *Field*, it is agreed that there is no direction given as to how much though the Examiner would insist that optimization of this parameter would have brought the skilled artisan to use similar quantities.

As for the notion that tables 5 and 6 outline an unexpectedly greater cohesive failure when combinations of (B), (C), and (D) are used together, the Examiner would agree if not for the fact that it is difficult to unequivocally attribute

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the differences in the results to this particular distinction between the trials. Comparative Example 3 is the only trial in which precisely the same amount of component (B) is used as in Examples 1 to 5. To the extent that there is more than one difference in each of the other pairs of experiments, it is not possible to conclude with any certainty that it is the simultaneous employment of (B), (C), and (D) that explains the differences in the cohesive failure ratio. Also noteworthy is that the performance differences appear to be smallest for Example 3 as it is the only Comparative trial for which the cohesive failure rating is no worse than  $\Delta$  in all cases. Moreover, because  $\Delta$  includes ratios that abut the ratio range for "O", 89% for instance, it is impossible to know just what the magnitude of the performance differences are. Again, given that Comparative Trial 3 is the only one for which approximately the same amount of component (B) is added, and the differences in its performance relative to that of Examples 1-5 are potentially quite small, the purported unexpected result associated with the employment of all of (B) through (D) is not verified by this particular set of experiments.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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October 2, 2009

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796